

## **REMARKS**

The Examiner is thanked for the thorough examination of this application. The present Office Action has, however, advanced new grounds for rejecting of all claims. Specifically, all independent claims are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Published Application 2004/0087164 to Bao et al. Applicants respectfully submit that these rejections should be withdrawn, as this cited reference is co-owned by the assignee of the present application.

Specifically, and as noted on the front page of the cited published application, Taiwan Semiconductor Manufacturing Company (TSMC) is the assignee of record for that published application. The present application has been assigned to TSMC as well (assignment recorded at reel/frame 014282/0943). In fact, two of the three inventors of the present application are the two inventors listed on the cited published application. Therefore, the pending claims are not invented "by another," and the rejection under 35 U.S.C. § 102(e) should be withdrawn.

Further still, as noted in Applicants' previous response:

As a separate and independent basis for the patentability of all pending claims, Applicant notes that the claimed invention was both conceived and reduced to practice before the Nov 4, 2002, filing date of Yeh. Consequently, Yeh is not prior art to the present invention. In this regard, the undersigned submits herewith a copy of an invention disclosure form that documents a conception date of the present invention that pre-dates the priority of Yeh. Should the Examiner not withdraw the rejections based on the substantive distinction set forth above, then the Applicant plans to submit a formal Declaration of inventor Tien-I Bao (pursuant to 37 C.F.R. §1.131 (with supporting documentation) that the invention, defined by the present-pending claims, was reduced to practice before Nov 4, 2002.

The filing date of the presently-cited published application is October 31, 2002, which is only 4 days earlier than the filing date of the previously-cited published application. Applicant notes that the claimed invention was both conceived and reduced to practice before the October

31, 2002, filing date of Bao. Further, the previously submitted invention disclosure document also evidences a conception date that predates well before the filing date of the presently-cited published application. Should the Examiner not withdraw the rejections, then the Applicants plan to submit a formal Declaration of inventor Tien-I Bao (pursuant to 37 C.F.R. §1.131 (with supporting documentation) that the invention, defined by the present-pending claims, was reduced to practice before October 31, 2002.

#### **Cited Art Made of Record**


The cited art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

#### **CONCLUSION**

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

By:   
Daniel R. McClure  
Registration No. 38,962

**Thomas, Kayden, Horstemeyer & Risley, LLP**  
100 Galleria Pkwy, NW  
Suite 1750  
Atlanta, GA 30339  
770-933-9500